

***Remarks***

Reconsideration of this Application is respectfully requested.

Claims 1-17 are currently pending in the application, with claims 1, 5, 8, 9 and 10 being the independent claims. Based on the following remarks, Applicants respectfully request that the claims be passed to allowance.

***I. Rejection of Claims 1-4, 8, 10, and 11 under 35 U.S.C. § 112***

The Examiner has rejected claims 1-4, 8, 10 and 11 under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the rejection.

The Examiner states that there is no structural cooperative relationship between the so called "means for mapping" and other recited elements in claims 1, 4 and 11. Applicants disagree. The means for mapping is part of the recited server. The recipient host "can access e-mails on said server" per claim 1. Thus, all the elements are connected as required by 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejection be withdrawn.

The Examiner also states that the phrase "sending an e-mail using physical address of a recipient" is unclear in claim 8. Applicants respectfully traverse. The Examiner is attempting to narrow the scope of Applicants' invention inappropriately based on his comments by reading limitations from the specification into the claims. This is inappropriate. *See* MPEP § 2173.04 ("Breadth of a claim is not to be equated with indefiniteness.") Applicants' invention is sending a e-mail using the physical address of the recipient. This is clearly recited in the claim. Also, the claim recites multiple steps, which have been ignored by the Examiner.

A similar argument applies to claim 10, which has also been rejected by the Examiner. Accordingly, Applicants respectfully request that the rejection to claims 8 and 10 be withdrawn.

***II. Rejection of Claims 1-17 under 35 U.S.C. § 103***

The Examiner has rejected claims 1-5, 11, 12-17 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,699,528 to Hogan ("the Hogan patent). Applicants respectfully traverse this rejection.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-73 (Fed. Cir. 1984). If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more evidence of unpatentability the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). In the present case, this burden has not been satisfied.

The Examiner in the above-captioned matter has changed the §102 rejection in the previous Office Action to a §103 rejection in the present action. However, the fact remains that Hogan fails to teach or suggest the claimed subject matter. As discussed in the previous Office Action, Hogan describes a technique for delivery of bills over a communication network, and payment of bills through the network using a personal computer. Hogan, col. 3, lines 47-50. A subscriber's personal data, including address and e-mail, are stored. Col. 5, lines 22-36. Subscriber's can access a bill via the Internet,

and pay the bill using one or more accounts. Col. 5, lines 1-5. The customer can view full graphics of the bills, print the bills, and download the bill for storage. Col. 5, lines 6-9.

Applicants' claimed invention is directed to allowing a party to send an electronic mail message (e-mail) using the physical address of a recipient instead of his/her e-mail address (which may be unknown). This is clearly not disclosed in Hogan. Nevertheless, the Examiner opines that it would be obvious to one of ordinary skill in the art to provide Hogan with an option of searching a recipient's e-mail address using a recipient's physical address. This assumes that the server in Hogan receives e-mail addressed using a physical address, which it does not. Accordingly, Hogan does not provide *any* suggestion for performing this step. Further, the Examiner has provided absolutely no motivation for Hogan to perform such a search within a billing system. The Examiner is clearly using impermissible hindsight to reject the claims.

The Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a database is old and well known. The fact that searching a database is well known does not make it obvious to map a physical address to an e-mail address (for sending an e-mail message). The Examiner is merely combining disparate portions of the art to reject the claimed invention. Applicants respectfully request that the Examiner provide a suggestion within the four corners of Hogan to use a physical address of a recipient to send an e-mail.

The Examiner takes Official Notice on multiple occasions throughout the Office Action. Applicants disagree in multiple instances, including that "providing Hogan with a search capability only involves ordinary skill in the art," "tagging an e-mail as time

sensitive is old and well known," "providing the e-mail server of Hogan with an option of tagging selected e-mails as time sensitive only involves ordinary skill in the art," "providing the e-mail server of Hogan with an option of using biometric data for accessing to [sic] an electronic mailbox involves ordinary skill in the art," and "sending e-mail notification to a buyer after an on-line purchase is a common practice in e-commerce." Applicants respectfully request that the Examiner provide proof of these statements that predates the filing date of the above-captioned application. These statements are unsupported by the record and therefore should not form the basis of a valid rejection.

Further, the Examiner has often jumped to the conclusion that combining two well known elements or process steps is obvious without any suggestion or motivation within the prior art. This is impermissible. Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The Examiner has failed to show that one of ordinary skill in the art would have been motivated by the combined teachings of the cited references in a manner which would have resulted in the claimed invention.

Based on the above, Applicants respectfully submit that claims 1-5, 11, 13, 14, 16 and 17 are patentable over the art of record, request that the rejection be withdrawn and that these claims be passed to allowance.

The Examiner has also rejected claims 6-9 as unpatentable over Hogan in view of U.S. Patent No. 6,343,327 to Daniel Jr. et al. (hereinafter Daniel) and/or Official Notice.

Applicants submit that Daniel and/or the Official Notice does not supply the missing teachings of Hogan discussed above. For at least these reasons, Applicants submit that claims 6-9, 12, and 15 are patentable over the art of record, request that the rejection be withdrawn and that these claims be passed to allowance.

The Examiner has also rejected claims 5 and 13 under §103 as unpatentable over Zoken. However, Zoken, like Hogan, fails to teach or suggest mapping a physical address of a recipient to an e-mail address as admitted by the Examiner. There is simply no motivation within Zoken to make such a modification to the system of Zoken. The Examiner is merely using impermissible hindsight. Accordingly, Applicants respectfully submit that claims 5 and 13 are patentable over the art of record, request that the rejection be withdrawn and that these claims be passed to allowance.

The Examiner has rejected claim 10 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,015,167 to Savino et al. ("the Savino patent"). Applicants respectfully traverse. As discussed above with reference to claims 1-9, Applicants' invention allows a physical address of a recipient to be used to send an e-mail. Independent claim 10 clearly recites this feature of Applicants' invention. The Savino patent fails to teach or suggest this feature. Further, the Examiner alleges that it was well known to send an e-mail notification to a buyer after an on-line purchase prior to the filing date of Applicants' application. Applicants respectfully request proof of this statement, and in particular that an e-mail be sent to a purchaser using his/her physical address as recited in claim 10. It is not enough for the Examiner to merely take Official Notice and then with hindsight opine that the claim is obvious. Accordingly, Applicants respectfully request that the rejection be withdrawn and that claim 10 be passed to allowance.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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